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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,293	01/02/2002	Arnold B. Finestone	82017-1399	1249

28765 7590 02/03/2003

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/03/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/038,293

Applicant(s)

FINESTONE ET AL.

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a pouch or container, classified in class 428, subclass 35.2.
  - II. Claims 12-20, drawn to a flexible plastic-paper-plastic laminate, classified in class 428, subclass 507.
2. Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as paper board used to form inexpensive furniture items and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
3. During a telephone conversation with Allan A. Fanucci on December 19, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 12-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### *Specification*

6. The abstract of the disclosure is objected to because the first two lines of the abstract refer to a pouch. The nonelected group of claims is directed to a pouch; the elected group of claims, which are directed to a laminate, do not recite a pouch. Please amend the abstract to describe the elected invention. Correction is required. See MPEP § 608.01(b).

#### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 12, the phrase "capable of being converted by conventional equipment into envelopes, bags and other dilatable container products... flat state" is indefinite. The phrase "capable of" renders the claim indefinite since it is unclear whether or not the cited limitation is

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intended to be a positive recitation. The scope of the claim cannot be ascertained due to the recitation of "capable of".

Claim 12 recites the limitation "said sheeting" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the product made from the sheeting" in the eleventh line of the claim. There is insufficient antecedent basis for this limitation in the claim.

In regard to claim 12, the phrase "treated to increase its dynes" (sixth and ninth lines of claim 12) is indefinite. Examiner suggests amending to "treated to increase the surface energy of the film". See page 7, lines 26-28 of specification.

In further regard to claim 12, the phrase "its dynes and its affinity" (sixth and ninth lines of claim) is indefinite because it is unclear what "its" is referring to. This phrase is also recited in claims 17 and 19.

The term "exceptional" in claim 12 is a relative term which renders the claim indefinite. The term "exceptional" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 13-20 recite the limitation "laminate sheeting" in the preamble of the claims. There is insufficient antecedent basis for this limitation in these claims.

The term "each" in claim 15 is indefinite. Is each intended to recite that both films must be composed of the same polymer, and/or that the two films are composed of different polymers? The term "white paper" is indefinite. The term "white" does not limit the composition or type of the paper.

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In regard to claim 16, the use of trademark and/or tradename Kraft renders the claims indefinite. By the use of a trademark and/or tradename in a claim, the scope of the claim is indefinite (Ex parte Simpson et al., 218 USPQ 1020).

In regard to claim 18, the term "the paper sheet" is indefinite. Which one? The paper sheet of claim 12 or the facing sheet of claim 17?

Claim 20 recites the limitation "second paper sheet" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redmond in view of Finestone et al.

In regard to claims 12 and 13, Redmond teaches a laminate including a sheet of relatively stiff, but flexible material such as paperboard (item 4, Fig. 4; col. 4, lines 46-49) covered at its

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opposite sides with plastic sealant films (items 6 and 8, Fig. 4; col. 3, lines 34-40). The paper sheet of Redmond is equivalent to the paper sheet as claimed by Applicants and the sealant films 6 and 8 of Redmond are equivalent to the first and second reinforcing films as claimed by Applicants. Redmond teaches that the first and second reinforcing films are adhesively fixed to the paper sheet (col. 3, lines 40-41). Redmond teaches that the laminate is made in a continuous strip that is formed into a coil from which the laminate is dispensed and cut into package size cards as its use is required for use on many types of packaging machinery (col. 4, line 52- col. 5, line 8); therefore, the laminate of Redmond is capable of being converted by conventional equipment into dilatable container products normally made of paper which are initially in a flat state. In reference to the recitations that the laminate is “capable of being converted...” and is “printable”, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Since the packages taught by Redmond are suited for packaging liquids, the laminate taught by Redmond is necessarily moisture resistant. In further regard to claim 12, the phrase “being cold-laminated by a water-based adhesive to the inside surface of the paper sheet” (lines 6-7) and “being cold-laminated by a water-based adhesive to the outside surface of the paper sheet” (lines 9-10) are method limitations. It is improper to include method limitations in article claims. The limitations of these phrases must be incorporated in the claim as article limitations.

Redmond fails to teach that the reinforcing films are oriented or biaxially oriented, that the inner surface of the reinforcing films are “treated to increase its dynes and its affinity to

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adhesives” and “cold-laminated by a water-based adhesive to the inside and outside surfaces of the paper sheet, respectively, and that the laminate has exceptional tear and burst strength.

However, Finestone et al. disclose a paper-plastic laminate having a plastic film (item 12, Fig. 5) laminated to a paper sheet (item 14, Fig. 5) via an adhesive layer (item 13, Fig. 5) (col. 5, lines 9-28). Finestone et al. disclose that the plastic film is oriented or biaxially oriented to increase the tensile strength of the film (col. 5, lines 9-19). Finestone et al. disclose that the surfaces of the film are subject to corona treatment that increases the surface energy (measured in dynes) of the film, thereby rendering the film wettable to allow for better bonding of the adhesives applied thereto (col. 6, lines 1-18). Finestone et al. disclose that the adhesive used for the adhesive layer is a water-based adhesive that permits cold lamination at ambient temperature since water-based adhesive is fluid at ambient temperature and therefore does not require heat (col. 5, lines 28-39). Finestone et al. disclose that cold lamination at ambient temperature enables the oriented film to maintain its orientation and is therefore essential to produce a laminate of high tear and burst strength (col. 5, lines 33-39).

Therefore, one of ordinary skill in the art would have recognized to have oriented the plastic film of Redmond in order to increase the tensile strength of the film as taught by Finestone et al., to have subjected the inner surface of the first and second reinforcing films of Redmond to corona treatment in order to increase the surface energy (measured in dynes) of the film, thereby rendering the film wettable to allow for better bonding of the adhesives applied thereto as taught by Finestone et al. and to have used water-based adhesive as the adhesive of Redmond in order to maintain the orientation of the oriented film during lamination to ensure a laminate of high tear and burst strength as taught by Finestone et al.



It would have been obvious to one of ordinary skill in the art at the time the invention was made to have oriented the plastic film of Redmond in order to increase the tensile strength of the film as taught by Finestone et al., to have subjected the inner surface of the first and second reinforcing films of Redmond to corona treatment in order to increase the surface energy (measured in dynes) of the film, thereby rendering the film wettable to allow for better bonding of the adhesives applied thereto as taught by Finestone et al. and to have used water-based adhesive as the adhesive of Redmond in order to maintain the orientation of the oriented film during lamination to ensure a laminate of high tear and burst strength as taught by Finestone et al.

In further regard to claim 12, the phrase "being cold-laminated by a water-based adhesive to the inside surface of the paper sheet" (lines 6-7) and "being cold-laminated by a water-based adhesive to the outside surface of the paper sheet" (lines 9-10) are method limitations. The method of forming the laminate is not germane to the issue of patentability of the laminate itself. Therefore, this limitation has not been given patentable weight, although the structure implied by this method step has been given patentable weight.

In regard to claims 14-16, Redmond fails to teach that the water-based adhesive is an acrylic polymer or a polyacrylate polymer, that each film is formed of polyester, polypropylene or polyethylene or that the paper sheet is Kraft paper or white paper.

However, Finestone et al. disclose that a polyacrylic copolymer is a suitable polymer for use as the water-based adhesive (col. 5, lines 26-27 and col. 7, line 47), that polyester, polypropylene and polyethylene are suitable materials for the plastic film (col. 5, lines 9-13 and col. 12, lines 29-30) and that Kraft paper is a suitable paper for the paper sheet (col. 10, lines 12-

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26). Therefore, one of ordinary skill in the art would have recognized to use the materials disclosed by Finestone et al. as the respective components of the laminate, since it is notoriously well known to use polyacrylic copolymer as a water-based adhesive, to use polyester, polypropylene or polyethylene as a plastic film and Kraft paper as a paper sheet as taught by Finestone et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the materials disclosed by Finestone et al. as the respective components of the laminate, since it is notoriously well known to use polyacrylic copolymer as a water-based adhesive, to use polyester, polypropylene or polyethylene as a plastic film and Kraft paper as a paper sheet as taught by Finestone et al.

In further regard to claims 15 and 16, the phrases “is formed of” (claim 15) and “is formed by” (claim 16) are method limitations. It is improper to include method limitations in article claims. The limitations of these phrases must be incorporated in the claim as article limitations. Examiner suggests amending to “each film is a film of polyester, polypropylene or polyethylene” and “the paper sheet is a sheet of Kraft paper or white paper”.

In regard to claims 17-20, Redmond fails to teach that an outer surface of one of the plastic films (in regard to claims 17 and 18) or both of the plastic films (in regard to claims 19 and 20 ) is/are surface treated to increase its dynes and its affinity to adhesives prior to lamination and that a facing sheet of paper is cold laminated to the treated outer surface/s of the plastic film/s, or that the facing sheet/s is/are formed of coated paper.

However, Finestone et al. disclose that a second paper layer (item 17, Fig. 6) is laminated to plastic film 12 via water-based adhesive 13 and that the outer surface of plastic film 12 is

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treated in order to render the surface wettable (col. 7, line 66-col. 8, line 6). The second paper layer Finestone et al. is the facing sheet as claimed by Applicants. Finestone et al. also disclose that coated paper is used as the outer finish liner of corrugated paper board for labeling the board with printed data or to apply decorative graphics thereto (col. 1, lines 21-28). Since Finestone et al. teach the interchangeable use of corrugated paper board and planar paper (col. 7, lines 39-41), one of ordinary skill in the art would have recognized to have adhesively laminated the facing layer (second paper layer 17) of Finestone et al. to one, or both, of the plastic films of Redmond et al. in order to provide an outer paper layer or outer paper layers to the laminate of Redmond for labeling the laminate with printed data or for applying decorative graphics thereto as taught by Finestone et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have to have adhesively laminated the facing layer (second paper layer 17) of Finestone et al. to one, or both, of the plastic films of Redmond et al. using the water-based adhesive taught by Finestone et al. in order to provide an outer paper layer or outer paper layers to the laminate of Redmond for labeling the laminate with printed data or for applying decorative graphics thereto as taught by Finestone et al.

In further regard to claims 17 and 19, the phrase “prior to lamination” is a method limitation. The method of forming the laminate is not germane to the issue of patentability of the laminate itself. Therefore, this limitation has not been given patentable weight.

In regard to claims 18 and 20, the phrase “is formed of” is a method limitation. It is improper to include method limitations in article claims. The limitations of these phrases must

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be incorporated in the claim as article limitations. Examiner suggests amending to "the... sheet is a sheet of coated paper".

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 4,096,309 to Stillman, U.S. 4,806,398 to Martin, U.S. 4,900,594 to Quick et al. and U.S. 5,332,586 to Di Mino.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba  
01/23/03

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1/22

1/24/03